

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

APPLE INC.,)	
)	
Plaintiff,)	
)	C.A. No. 22-1377-MN-JLH
v.)	
)	JURY TRIAL DEMANDED
MASIMO CORPORATION and)	
SOUND UNITED, LLC,)	
)	
Defendants.)	
<hr/>		
MASIMO CORPORATION,)	
)	
Counter-Claimant,)	
)	
v.)	
)	
APPLE INC.,)	
)	
Counter-Defendant.)	
<hr/>		
APPLE INC.,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. 22-1378-MN-JLH
)	
MASIMO CORPORATION and)	
SOUND UNITED, LLC,)	
)	
Defendants.)	
<hr/>		
MASIMO CORPORATION and)	
CERCACOR LABORATORIES, INC.,)	
)	
Counter-Claimants,)	
)	
v.)	
)	
APPLE INC.,)	
)	
Counter-Defendant.)	

PLAINTIFF AND COUNTERCLAIM-DEFENDANT APPLE INC.’S MOTION TO DISMISS AND STRIKE SOUND UNITED’S ANSWER AND COUNTERCLAIMS

On December 12, 2022, Defendant and Counterclaimant Sound United, LLC (“Sound United”) moved to dismiss Plaintiff and Counterclaim-Defendant Apple Inc.’s (“Apple”) Complaint. D.I. 29 (-1377); D.I. 13 (-1378). On February 21, 2023, Apple moved to dismiss Defendant and Counterclaim-Plaintiff Masimo Corporation’s (“Masimo”) counterclaims and to strike certain of its affirmative defenses. D.I. 54 (-1377); D.I. 39 (-1378). On June 20, 2023, this Court issued its Report and Recommendation (the “R&R”), recommending that both motions be denied. D.I. 131 (-1377); D.I. 124 (-1378).

On June 23, 2023, Judge Noreika granted Masimo’s motions for leave to amend, D.I. 136 (-1377); D.I. 130 (-1378), and denied Apple’s motions as moot, D.I. 139 (-1377); D.I. 133 (-1378). Since Masimo’s amended pleading did not materially change the theories that Apple moved to dismiss, Apple promptly filed an unopposed motion for this Court to reissue its R&R as applied to the amended counterclaims and defenses in both of the above-captioned matters so Apple could file narrow objections on just two particularly important points. D.I. 145 (-1377); D.I. 140 (-1378). Apple renewed its motions to dismiss and to strike, but only with respect to the two issues, including to dismiss and strike the inequitable conduct counterclaims and defenses insofar as they are premised on the alleged conduct of Apple’s Chief IP Counsel and incorporated its prior briefing on this issue. D.I. 158 (-1377); D.I. 153 (-1378).

On July 10, 2023, the Court adopted the R&R as to Sound United, denying Sound United’s Motions to Dismiss. D.I. 164 (-1377); D.I. 160 (-1378). Sound United filed its Answer to the Complaint and Counterclaims on July 5, 2023. D.I. 151 (-1377); D.I. 146 (-1378). The inequitable conduct counterclaims and defenses in Sound United’s Answer are identical to those found in Masimo’s Amended Answer, including those premised on the alleged conduct of Apple’s Chief

IP Counsel. *Compare* D.I. 151 (-1377) at 8-39 (Second Defense), 43-44 (Count III) *with* D.I. 138 (-1377) at 11-42 (Second Defense), 46-47 (Count III); *compare* D.I. 146 (-1378) at 15 (Second Defense), 18-37 (“Fraudulent Conduct Before the USPTO”), 47-48 (Counts 13–15) *with* D.I. 132 (-1378) at 17 (Second Defense), 75-94 (“Fraudulent Conduct with Respect to Utility Patents”), 166-167 (Counts 29 –31).

Because Sound United’s Answer includes identical allegations regarding inequitable conduct as Masimo’s Answer, Apple moves to respectively dismiss and strike the inequitable conduct counterclaims and defenses insofar as they are premised on the alleged conduct of Apple’s Chief IP Counsel. In support of its motion, Apple expressly incorporates its prior briefing on this issue. D.I. 158 (-1377); D.I. 153 (-1378); D.I. 55 at 11-18 (-1377); D.I. 88 at 4-9 (-1377); D.I. 40 at 16-20 (-1378); D.I. 76 at 9-10 (-1378).

Apple requests that the Court resolve this motion by issuing as to Sound United’s allegations the same R&R the Court issued as to Masimo’s allegations (and for which Apple requested the Court reissue as to Masimo’s amended pleading) regarding the inequitable conduct allegations relating to Apple’s Chief IP Counsel.

Respectfully submitted,
POTTER ANDERSON & CORROON LLP

OF COUNSEL:

John M. Desmarais
Jordan N. Malz
Cosmin Maier
Kerri-Ann Limbeek
Jeffrey Scott Seddon, II
DESMARAIS LLP
230 Park Avenue
New York, NY 10169
Tel: (212) 351-3400

By: /s/ David E. Moore
David E. Moore (#3983)
Bindu A. Palapura (#5370)
Andrew L. Brown (#6766)
Hercules Plaza, 6th Floor
1313 N. Market Street
Wilmington, DE 19801
Tel: (302) 984-6000
dmoore@potteranderson.com
bpalapura@potteranderson.com
abrown@potteranderson.com

Peter C. Magic
DESMARAIS LLP
101 California Street
San Francisco, CA 94111
Tel: (415) 573-1900

*Attorneys for Plaintiff/Counter-Defendant
Apple Inc.*

Jennifer Milici
Leon B. Greenfield
Dominic Vote
WILMER CUTLER PICKERING HALE
AND DORR LLP
2100 Pennsylvania Avenue NW
Washington, DC 20037
Tel: (202) 663-6000

Mark A. Ford
WILMER CUTLER PICKERING HALE
AND DORR LLP
60 State Street
Boston, MA 02109
Tel: (617) 526-6423

Dated: July 18, 2023
10923445 / 12209.00051